

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 8304**
Osamu SAKANAKA et al. : Docket No. 2000-1081A
Serial No. 09/601,655 : Group Art Unit 1625
Filed August 4, 2000 : Examiner Binta M. Robinson

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NOVEL ANTIFUNGAL COMPOUND AND
PROCESS FOR PRODUCING THE SAME

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.**

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JUN 18 2004

Sir:

TECH CENTER 1600/2900

Responsive to the Office Action of September 24, 2003, the time for responding thereto being extended for two months in accordance with a Petition for Extension of Time submitted herewith, Applicants submit the following remarks in support of the allowance of the present claims. Further and favorable reconsideration is respectfully requested in view of these remarks.

Initially, the Office Action Summary page indicates that the pending claims are claims 1, 3, 9, 10, 14, 19, 21, 29 and 31. However, claims 20, 23-28, 30 and 32 are also pending in the application. Therefore, the claims pending at the time of issuance of the Office Action were claims 1, 3, 9, 10, 14, 19-21 and 23-32.

As correctly indicated by the Examiner, Applicants elected Groups I and IV in response to the restriction requirement previously issued by the Examiner. In responding to the restriction requirement, Applicants noted that the pending claims were claims 1, 3, 9, 10, 14, 19-21 and 23-32. The restriction requirement does not indicate which Groups cover claims 20 and 23-28. Furthermore, the Office Action of September 24, 2003 does not refer to claims 20 and 23-28, nor does the Office

Action refer to claims 30 or 32. In this regard, as noted in MPEP 707, the Office Action Summary page should set forth “the position taken on all the claims.” (Emphasis added)

The rejection of claim 14 under the first paragraph of 35 U.S.C. §112 is respectfully traversed.

The Examiner indicates that claim 14 is directed to a method of preventing fungal diseases or fungi, whereas most drugs do not prevent but treat disease.

However, claim 14 (see page 2 of the Amendment filed May 23, 2002) recites a method for treating fungal infectious diseases, and does not recite a method for preventing fungal infectious diseases.

Accordingly, the rejection of claim 14 under the first paragraph of 35 U.S.C. §112 should be withdrawn.

Incidentally, although on page 3 of the Office Action the Examiner refer to R^2 radicals for compounds 53 and 56 in Table 2 (page 60 of the specification), Table 2 has been amended (see the Amendment filed February 27, 2003) to change R^2 to R^3 in both the formula and in the heading for the list of substituents for Examples 53-56.

The rejection of claims 1 and 3 under the second paragraph of 35 U.S.C. §112 is respectfully traversed.

As correctly noted by the Examiner, claim 1 refers to “a substituent” (three occurrences). However, claim 1 also includes a Markush group to define the substituent, i.e. “the substituent is selected from the group consisting of hydroxyl . . . and diphenylphosphoryloxy”. Thus, contrary to the position taken by the Examiner, it is clear from claim 1 what substituents Applicants are talking about.

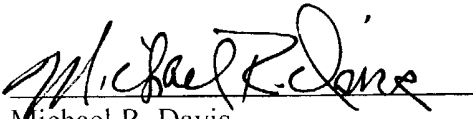
Therefore, it is apparent that the rejection of claims 1 and 3 under the second paragraph of 35 U.S.C. §112 should also be withdrawn.

The objection to claims 9-10, 19, 21, 29 and 31 is noted. However, although the Examiner states that these claims are based on a rejected claim, Applicants note that claim 21 is an independent claim. Furthermore, since the rejections set forth by the Examiner should be withdrawn for the reasons indicated above, it is apparent that for this reason alone the objection to the claims should be withdrawn.

Therefore, the application is now considered to be in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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